

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Marty Williams

Attorney Dkt. No.: 10.18.07.USP

Application No.: 10/711,961

Examiner: Gross, Harry A.

Filing Date: 2004.10.15

Title: CRATE SYSTEM

PETITION TO REVIVE PATENT APPLICATION UNAVOIDABLY ABANDONED;  
REQUEST FOR CONTINUED EXAMINATION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

August 6<sup>th</sup>, 2010

Assistant Commissioner:

37 CFR 1.377 provides that a patent application may be reinstated if the delay in reply by applicant or patent owner was unavoidable. Petitioner just recently had the Power of Attorney changed and now Petitioner respectfully requests that patent application number 10/711,961 be reinstated as unavoidably abandoned.

Previously today Applicant submitted a petition to revive the subject patent application as unintentionally abandoned, along with the fees to revive unintentionally abandoned application and a response to the outstanding Final Office Action. Upon further review Applicant herewith request and submits:

1. Petition to revive an application as unavoidably abandoned, thus replacing the petition to revive under the unintentional standard;
2. Complete statement of facts as to why the delay was unavoidable along with supporting statements;
3. A request for continued examination (RCE) and the requisite fees;
4. A request for a refund in the amount of \$135. Applicant previously paid \$810 for the unintentionally abandoned revival petition. If the Office grants the present petition then the fee should be \$270 for revival for unavoidably abandoned, plus the \$405 RCE fee for a total of \$675.

Petitioner would also like to note that this petition is being sent in conjunction with several other petitions for revival under the unavoidably abandoned standard for the exact same reasons as outlined below.

Reason for Abandonment

Facts: Petitioner has had a long time standing relationship with the same patent legal Counsel (hereinafter "Counsel") for almost twenty years, dating back to at least August of 1990. Over the course of this twenty year period Counsel filed numerous patent applications that have resulted in eight patents being issued thus far and many other applications that are still pending. For all patent applications over this same time frame Counsel has been the attorney of record at the PTO for all patent applications pending for the Petitioner. Additionally, at all times Counsel was the only point of contact at the USPTO and has been the agent for Petitioner continuously since the relationship started almost twenty years ago. Finally, on all issuance documents Counsel was named as the only correspondent for all future correspondence with the USPTO, with respect to maintenance payments and any and all PTO correspondence. Thus, Petitioner has never had any direct contact with the United States Patent and Trademark Office. All correspondence has been through Petitioner's long time, trusted Counsel.

Petitioner is in the business of inventing and manufacturing travel and outdoor recreational products, such as trailer systems, hitch pins for towing systems, tent systems, and cargo systems, just to mention a few. Over the course of the last twenty years in business Petitioner has worked with and relied on Counsel for patent advice and legal advice and over this same time Counsel provided exceptional service, dedication to Petitioner and Petitioner's business and intelligent insight with respect to patent drafting, patent prosecution, patent management and even licensing.

Due to Petitioner's growing patent portfolio Petitioner attracted the attention of several companies that wished to acquire some of Petitioner's intellectual property through licensing. Counsel was asked to assist with the matter and eventually Petitioner, with Counsel's assistance, successfully licensed a number of Petitioner's patents, along with some pending applications. Because of their relationship and because Counsel helped draft the agreement Counsel was entirely aware of which patents and which applications formed

the body of the license agreement. This license is extremely important to Petitioner because it provides a continual and substantial stream of income into Petitioner's business. The intellectual property involved in this license is the main concern for Petitioner at the present and is the main body of work to be revived currently.

Since the beginning of their relationship Counsel and Petitioner worked together as a team and thus a deep seated trust grew, developed and existed throughout the relationship. Even during the past several years Petitioner believed that it has been "business as usual" and had no reason whatsoever to believe that anything was wrong. Petitioner has continued to invent, manufacture and sell products, Counsel has maintained the Intellectual Property portfolio, and Licensee has paid Petitioner royalties on the Intellectual Property licensed.

However, during the course of a regular inspection and review of their licensed properties it came to the attention of the Licensee that the majority of their licensed properties were either abandoned or were about to become abandoned. Alarmed by this fact the Licensee contacted the Petitioner and Petitioner immediately contacted Counsel to find out the status of the intellectual property. Counsel confirmed that indeed a majority of the patents and applications had gone abandoned.

Counsel explained to Petitioner that over the past few years he has suffered and continues to suffer chronic depression. Because of these difficulties Counsel's performance began to suffer and his attention to client matters began to suffer. Part of the work that was affected by Counsel's state of mind was Petitioner's portfolio. Counsel has independently confirmed that his depression, state of mind and mental ability to perform all took place in conjunction with the failure to maintain Petitioner's Intellectual Property portfolio. Over time Counsel's mental state did not improve and in fact worsened and Counsel at no time notified Petitioner of the deteriorating state of his Intellectual Property. In fact and to the contrary, Counsel continued to assure Petitioner through email and phone conversations that his patent portfolio was safe, fees were paid and that Counsel continued to maintain Petitioner's portfolio.

However, this was not the case. For approximately the last three to four years Petitioner has had numerous patents go abandoned for failure to pay maintenance fees and has had numerous other patent applications go abandoned for failure to pay filing fees,

extension fees and for failure to respond to outstanding office actions, all due to Counsel's ineffectiveness of Counsel, breach of fiduciary duty and malfeasance. Again, this has all occurred over the past few years and not during the entire time Petitioner had a relationship with Counsel.

Immediately after finding out about the severity of the matter and the condition of Petitioner's Intellectual Property portfolio Petitioner took several affirmative steps in order to rejuvenate and revive his patent portfolio and to revive, prosecute and maintain his patent applications. First, he contacted me, Tracy M Heims, at Apex Juris, pllc. I have known the Petitioner for about six years and have occasionally answered questions for Petitioner with respect to patents and applications, however, Petitioner always stressed to me that he was entirely satisfied with his Counsel, that he trusted Counsel as he started out with him when he first started the business and started filing applications and that Counsel was not only his attorney but also his friend. It was my impression that he relied on Counsel entirely and exclusively for filing applications and for maintaining his Intellectual Property and that Counsel was almost treated like in-house Counsel due to the closeness of their relationship and due to the deep seated trust Petitioner had in Counsel. However, now, in light of the present situation, with deep regret Petitioner finds it necessary to move his Intellectual Property portfolio in order to effectively protect his rights.

Next, after moving his portfolio from previous Counsel to Apex Juris, pllc, Petitioner immediately began reviving all patents and patent applications that went abandoned for whatever reason. Petitioner has seven pending applications that are all now in the revival process. Petitioner has five patents that are also in the process of being revived. Two of these patents have already been revived and fees paid under the unintentionally abandoned standard. This was done mainly because Applicant wanted the patents revived as soon as possible. Three patents, however, are already past the two year statutory revival period for revival under this standard. These patents are now all being petitioned for revival under the unavoidably abandoned standard. These are patent numbers 6,398,290; 6,213,539 and 6,042,175. Obviously this is going to be excessively expensive for Petitioner but his patent portfolio is extremely important to him, to his company and to the survival of his business and thus Petitioner is moving forward with all revivals.

Statutory guidelines for revival under 37 CFR 1.137

37 CFR 1.137 provides: Unavoidable. If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under § 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;--this response was submitted earlier today
- (2) The petition fee as set forth in § 1.17(l);--attached hereto electronically
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable;

Applicant had a trusted confidant, colleague and patent attorney with whom he had a long term relationship. Petitioner relied completely and entirely on Counsel to prosecute and maintain his intellectual property portfolio. Petitioner believed that Counsel was maintaining his patent portfolio and he had no reason to believe otherwise. Also as noted above, immediately upon finding out that his portfolio was in jeopardy Petitioner took immediate steps to revive ALL patents and patent applications.

The above is Petitioner's statement of facts as he knows them. Further, Petitioner herewith provides sworn statements by: Petitioner's previous Counsel; Sara Williams, Mr. Williams wife and co-founder of their company, LGA; and Eric Nickerson, Controller for LGA, attached hereto and made a part hereof by this reference as Exhibits A, B and C respectively, as to the accuracy of the facts recited herein and a complete explanation as to why Counsel did not pay annuity payments, filing fees, office action fees and did not timely respond to the United States Patent and Trademark Office. The Office should note that the statements were prepared in conjunction with the patent revivals. However, Mr. Webb was counsel for the subject patent application at the same time and the same issues existed and thus Applicant feels that the statements are also applicable to this application and are included for that reason.

It is understood that the "unavoidable" delay standard is the same for patents as it is for patent applications. MPEP § 711.03(c) states "A showing of unavoidable delay will (in

addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay.” With deference to the standard of care required, Petitioner understands the heightened proof required for a finding of unavoidably abandoned. However, Petitioner submits that he meets that burden.

First, as argued above, Petitioner has been associated with Counsel continually for a long period of time, almost twenty years. During this time Petitioner relied on Counsel for filing and maintaining his IP portfolio. Petitioner at no time had reason to believe that Counsel was suffering from depression or that Counsel’s mental state was affecting Counsel’s ability to maintain Petitioner’s portfolio. Petitioner retained Counsel and genuinely believed that Counsel had proper procedures and filing mechanisms in place as a professional to maintain Petitioner’s IP portfolio.

With respect to the second requirement, concerning the training and experience of the persons responsible for the error, it is noted that Counsel is a licensed attorney in the state of Colorado and further is licensed to practice before the USPTO. Knowing this it is asserted that Petitioner performed sufficient due diligence in hiring Counsel as Petitioner’s patent Counsel and also that Petitioner was reasonable to rely on Counsel to professionally attend to Petitioner’s patent matters.

With respect to the third requirement, that copies of any applicable docketing records should be submitted to show that the error was in fact the cause of the delay should be provided. Previous counsel’s statement of facts asserts that those records are not available due to the fact that his docketing policy did not work as intended. However, the USPTO records show Counsel as the only correspondent listed on the patents and applications and also shows the number of patents and applications that recently went abandoned for failure to pay fees. In all cases, Counsel is listed as the correspondent on all records.

The Office requires specifically the payment of fees at specified intervals to maintain a patent in force, and requires the Patentee exercise the same care that “a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure

the timely payment of such maintenance fees. *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. *Id.* MPEP 2590. The standard set out is “reasonably prudent person”. Petitioner submits that any reasonably prudent person would believe that their Counsel of twenty years would continue to act as he has acted for the past twenty years and that those actions would include paying maintenance fees, paying filing fees, responding to office actions, paying issue fees, and any and all other correspondence with the USPTO as required to maintain an IP portfolio. A reasonably prudent person would have no reason to believe that his professional Counsel would suddenly suffer from depression and cease all actions with respect to his IP portfolio, especially when all correspondence from Counsel indicated otherwise.

Conclusion:

Petitioner believes that this patent application is eligible for revival under the unavoidable standard. As soon as Petitioner became aware of the dire situation regarding his Intellectual Property portfolio he took immediate action to pay fees, submit petitions and revive all applications and patents. Petitioner reasonably relied on his professional Counsel, Counsel licensed in Colorado and before the USPTO, and Petitioner’s Counsel of twenty years, to maintain Petitioner’s Intellectual Property portfolio and due to no fault of Petitioner’s, Counsel failed to maintain Petitioner’s portfolio and specifically, failed to notify Applicant and/or respond to the outstanding Final Office Action. Thus, Petitioner respectfully pleads and requests that the Office and Petitions Board grants this revival under the unavoidably abandoned standard.

Should the Office believe further discussion regarding the above request for revival is required they are invited to contact the undersigned at the number listed below.

Respectfully submitted,

/Tracy M Heims 53010/

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